

### **REMARKS**

Prior to this response, claims 13, 33, 35-50, 58-66, and 76-83 were pending in the application. Claims 13, 33, 35, 36, 38-40, and 59 have been amended in the above amendments. Claims 37 and 58 have been cancelled. No claims have been added. Accordingly, claims 13, 33, 35-36, 38-50, 58-66, and 76-84, of which claims 13, 76, and 83 are independent, are still pending in the application.

Applicant would like to thank the Examiner for taking the time to meet with Applicant's representative, Mr. Noel C. Gillespie, on December 3, 2007.

#### **Claim Objections**

Paragraph 3 of the Action objects to claims 33, 35, 36, 40, 58, and 59 because they mistakenly depended on claim 57, which was cancelled in the last Response. Applicant has cancelled claim 58 and Applicant has amended the other claims to correctly depend from claim 13. Applicant, therefore respectfully requests withdrawal of the objection.

#### **Claim Rejections Under §112**

Paragraph 5 of the Action rejects claim 84 under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. Specifically, the Action states that the limitation “. . . wherein the at least one advertisement associated with the source is less than 1 second long,” is not described in the specification. Applicant respectfully traverses this rejection, because one of skill in the art would be enabled after reading Applicant's specification

of implementing a system in which “the at least one advertisement associated with the source is less than 1 second long.”

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.").

In this case, one of skill in the art would clearly understand that a ring tone in a ring back signal can be less than 1 second long. Accordingly, the specification as filed inherently teaches that an advertisement replacing a ring tone in a ring back signal can be less than 1 second long, as this is well known in the art. A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986),

*cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

But in any event, it would not take undue experimentation for one of skill in the art to implement a system as claimed in claim 84. In other words, the claimed invention is enabled so that any person skilled in the art can make and use the invention without undue experimentation.

Accordingly, Applicant respectfully request withdrawal of the rejection.

**Claim Rejections Under §103:**

Paragraph 6 of the Action rejects claims 13, 33, 35-48, 58-64 and 84 under 35 U.S.C. §103(a) as being unpatentable over Gregorek (U.S. Patent 5,557,658) in view of Hidary (U.S. Patent 5,852,775) in further view of Inoue (JP 57087661). Applicant has cancelled claims 37 and 58 thereby rendering the rejection moot as to these claims. Applicant therefore respectfully requests withdrawal of the rejection as to claims 37 and 58; however, Applicant expressly reserves the right to pursue any patentable material contained in claims 37 and 58 at a later time. With respect to the remaining claims, Applicant respectfully traverses this rejection for at least the reasons stated below.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” See MPEP §706.02(j).

In this case, the Action fails to make out *prima facie* case of obviousness because Gregorek, Hidary, and Inoue, alone or in combination, do not teach each and every limitation of the claims. Claim 13 includes the limitation of replacing the ring tones in a ring back signal with short advertisements. This limitation has been present in the claims from early on and has been rejected under various combinations, including Gregory and Hidary, in previous Actions. In each instance, Applicant has overcome the rejections by pointing out that the prior art does not in fact teach replacing the ring tones in a ring back signal with short advertisements, and this rejection is no different.

For example, a previous Action stated that the claims do not sufficiently recite replacing the rings of a ring back signals with a series of short advertisements as opposed to replacing the entire ring back signal. Applicant respectfully disagreed because the claims (including claim 13 in its present form) recite “. . . cause . . . [a] short advertisement associated with the source to replace the rings of a ring back signal.” Accordingly, Applicant asserted, and still asserts that the claims cite sufficient detail.

A previous Action further stated that the ring back signal is also short and that an advertisement that replaced the ring back signal would therefore be short. Applicant noted that this statement apparently admits Gregorek teaches replacing the ring back signal and not the individual ring tones. Applicant further noted that while a ring back signal may be short, it is clearly not as short as the ring tones. Thus, a continuous message of 5-30 seconds as taught in Gregorek clearly would not be sufficient to achieve the invention as claimed in claims 76 and 83, and now 13.

Previous Actions attempted to address Applicant’s previous arguments that the prior does not teach replacing the ring tones of the ring back signal with short advertisement, by stating that

“[t]his is irrelevant to the claimed invention.” Applicant of course respectfully disagreed, because as Applicant noted the limitations at issue are expressly contained in three separate claims (34 (now 13) 76, and 83), two of which (claims 76 and 83) are independent claims. Thus, Applicant noted that the limitations were quite relevant.

Applicant has also noted in the past that it is an unquestioned tenant of patent law that in order for a reference to render a claim unpatentable, it must teach each and every element of the invention as claimed. Moreover, “the identical invention must be shown in as complete detail as contained in the . . . claim.” (See MPEP §2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Applicant noted that the art cited in previous Actions, including Gregorek, did not teach the above limitation and that more recent Actions made no assertion to the contrary, but rather tried to overcome the deficiencies in the cited references by stating, e.g., that it is not relevant to the claimed inventions, which is clearly not the case.

After several Actions that while rejecting claims 34 (now 13), 76, and 83, put forth no new grounds for rejecting claims 34 (now 13), 76, and 83, the present Action now states that Inoue teaches this limitation; however, Inoue too does not teach this limitation. Inoue appears to teach two embodiments: One in which a Talkie signal (TKE) is superimposed over the entire ring back signal (Fig. 3(b)) , and a second in which the period between the ring tones (RBT) is replaced with a TKE signal (Fig. 39a)). In this regard, Inoue is merely cumulative with respect to the Sleevi patent already disclosed in the background of the present application. Thus, Inoue does not teach that the actual ring tones (RBT) can be replaced. It should be noted therefore that the Action misinterprets what is being described in Fig. 3(a).

As discussed in the interview of December 3, 2007, the difference between Applicant's claims and Inoue can be found on page 4 of the translation in the third full paragraph where it states: "In Figure 3(a), talkie signal TKE is transmitted when the callout signal RBT is not transmitted (emphasis added)." Whereas, in claim 13, the advertisements are transmitted when RBT signal is transmitted, or more specifically during the period the RBT signal would be transmitted, since the advertisements replace the ring tone or RBT portion of a ringback signal.

Accordingly, as with the art previously cited, Inoue also fails to disclose this limitation. Based on the above, Applicant respectfully asserts the claim 13 is allowable over the art of record. Claims 33, 35, 36, and 38-48, 59-64 and 84 ultimately depend from claim 13 and are therefore allowable for at least the reasons discussed with respect to claim 13. Applicant, therefore respectfully requests withdrawal of the rejection of claims 13, 33, 35-48, 58-64 and 84.

Paragraph 7 of the Action rejects claims 49-50 and 65-66 under 35 U.S.C. §103(a) as being unpatentable over Gregorek in view of Hidary, in further view of Inoue, in further view of Creamer (U.S. Patent 6,028,917). Claims 49-50 and 65-66 ultimately depend from claim 13 and are therefore, allowable for at least these same reason unless Creamer can make up for the deficiencies of Gregorek and Hidary, which it cannot. Applicant therefore respectfully request withdrawal of the rejection as to claims 49-50 and 65-66.

Paragraph 8 of the Action rejects claim 76 under 35 U.S.C. §103(a) as being unpatentable over Chavez Jr. (U.S. Patent 6,603,844), in view of Inoue. Applicant respectfully traverses the rejection because neither Chavez, Jr., nor Inoue, alone or in combination, teach every limitation of claim 76.

Similar to claim 13, claim 76 includes replacing the ring tones of a ring back signal with a short advertisement. The Action admits that Chavez Jr. does not teach this limitation, and as

explained above, neither does Inuoe. Accordingly, the Action fails to make out a *prima facie* case of obviousness with respect to claim 76 and Applicant respectfully requests that the rejection be withdrawn.

Paragraph 9 of the Action rejects claims 77 and 83 under 35 U.S.C. §103(a) as being unpatentable over Chavez Jr. in view of Inoue, in further view of Gregorek. Claim 77 depends from claim 76 and is therefore allowable for the same reasons as discussed with respect to claim 76 and 13. Similar to claim 13, claim 83 includes replacing the ring tones of a ring back signal with a short advertisement. Accordingly, claim 83 is allowable for the reasons discussed above. Applicant therefore, respectfully requests withdrawal of the rejection as to claims 77 and 83.

Paragraph 10 of the Action rejects claim 78-82 under 35 U.S.C. §103(a) as being unpatentable over Chavez Jr., in further view of Inoue, in further view of Hidary. Claims 78-82 ultimately depend from claim 76 and are therefore allowable for at least the reasons discussed with respect to claim 76 and 13. Applicant therefore respectfully requests withdrawal of the rejection of claims 78-82.

**CONCLUSION**

Applicant believes that given the above amendments and remarks, the claims are now in condition for allowance and such is respectfully requested. No new claim fees are believed to be necessitated by this response. The Examiner is requested to charge any additional fees that may due with this response to deposit account 13-0480.

Respectfully submitted,

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